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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,725	03/30/2001	David Art Mann	K35A0785	5978

35219 7590 05/02/2005

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EXAMINER

CARDONE, JASON D

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,725

Applicant(s)

MANN, DAVID ART

Examiner

Jason D. Cardone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 11, 12 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 11, 12 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the amendment of the applicant, filed on 12/29/04.

Claims 1, 11, 12 and 17 are presented for further examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 11, 12 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims disclose an executable file executing upon the next boot-up. The specification does not disclose this action. The specification discloses that the executable file could be in a startup folder [Specification, page 8, lines 5-8] but does not disclose executing the executable upon boot-up.

4. Claims 1, 11, 12 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make

and/or use the invention. The claims disclose an executable file executing upon the next boot-up with the use of the key file storing and executing the file. The specification is silent on how this is done. The specification discloses the key file including an indicator that the executable file should be in a startup folder. The specification does not teach that the key file does an action to the executable file (ie. storing, in claim 1, or executing, in claim 17). Also, The specification does not disclose how the executable file is executed at boot-up.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 11 recites the limitation "said running". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 11, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hobbs, USPN 6,523,022 in view of Parthasarathy et al. ("Parthasarathy"), USPN 6,802,061.

10. Regarding claim 1, Hobbs discloses a method of receiving data at a client computer and performing an operation on the data received at the client computer, the method comprising:

receiving a key file at the client computer, the key file comprising a rule identifying the operation to be performed on the data received at the client computer [ie. embedded application, Hobbs, col. 28, line 56 – col. 29, line 33;

receiving the data at the client computer [Hobbs, col. 27, lines 16-22 and col. 29, lines 1-20]; and

performing the operation identified by the rule in the key file on the data received at the client computer [Hobbs, col. 29, lines 12-33 and col. 29, line 65 – col. 30, line 11], wherein;

the data is an executable file) [ie. running the Active X, Hobbs, col. 22, lines 28-66 and col. 29, lines 1-33];

the key file storing the executable file at the client computer [Hobbs, col. 29, lines 12-33 and col. 29, line 65 – col. 30, line 11].

Hobbs substantially discloses the instant claimed invention. Hobbs does not specifically disclose the executable file is executed upon the next boot-up of the client computer. However, Parthasarathy, in the same downloading software field, discloses

a file indicating that a executable file will execute upon the next boot-up of the client computer [ie. CIP_NEED_REBOOT, Parthasarathy, col. 23, middle of column].

11. Regarding claim 11, Hobbs-Parthasarathy further discloses running the executable file occurs a plurality of times upon subsequent boot-ups of the client computer [Hobbs, col. 22, lines 28-66 and col. 29, lines 1-33] [Parthasarathy, col. 23, middle of column].

12. Regarding claim 12, Hobbs-Parthasarathy further discloses displaying a message at the client computer upon receipt of the executable file [Hobbs, col. 29, lines 1-33] [Parthasarathy, col. 21, line 26 – col. 22, line 21].

13. Regarding claim 17, claim 17 has similar limitations as claim 1. Therefore, it is rejected under Hobbs-Parthasarathy for the same reasons set forth in the rejection of claim 1 [Supra 1].

Conclusion

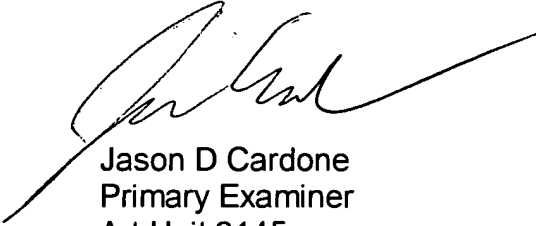
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D. Cardone whose telephone number is (571) 272-3933. The examiner can normally be reached on Mon.-Thu. (6AM-3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason D Cardone
Primary Examiner
Art Unit 2145

April 28, 2005